REMARKS

Claim 87 has been amended to incorporate the limitations of claim 90, which has been cancelled accordingly. Claims 67 and 82-84 also have been cancelled. No new matter has been added. Applicants respectfully reconsideration and allowance of claims 61, 69-72, 74-81, and 85-89 in view of the above amendments and following remarks.

Applicants acknowledge the withdrawal of the rejection of claims 61, 67, 69-72, and 74-81 under 35 U.S.C. §112, first paragraph for lack of enablement.

Claim Objections

The Office objected to claim 67 under 37 C.F.R. §1.75(c) for being an improper dependent claim for failing to further limit the subject matter of the previous claim. This objection is moot as claim 67 has been cancelled.

Rejection under 35 U.S.C. §112, second paragraph

The Office rejected claims 87-89 under 35 U.S.C. §112, second paragraph, for being indefinite with respect to the phrase "hybridizes under highly stringent conditions."

While Applicants disagree with the rejection, claim 87 has been amended to incorporate the limitations of claim 90, which has been cancelled accordingly.

Rejection under 35 U.S.C. §102(e)/§103

The Office rejected claims 87-89 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication No. 2004/0110792 (the '792 publication). The Office also rejected claims 87-90 as being obvious in view of the '792 publication. The Office asserted that Sequence 293 from the '792 publication shares sequence homology with Applicants' SEQ ID NO:1320. The Office further asserted that the '792 publication discloses a method of analyzing gene expression profiles of a patient with acute myelogenous leukemia (AML) and assessing the leukemia, and cited to [0030, [0031], [0039]-[0043], and Example 6 of the '792 publication.

Claim 87 has been amended to incorporate the limitations of claim 90, which has been cancelled accordingly. The '792 publication does not disclose a method of diagnosing lymphoma, leukemia, carcinoma, breast cancer or colon cancer as recited in amended claim 87.

Rather, the '792 publication discloses methods for determining whether a patient is likely to respond to a farnesyl transferase inhibitor (FTI), methods for monitoring patient therapy, and methods for selecting therapy. The passage at [0030] of the '792 publication indicates that gene expression intensities from a tissue that has been treated with a drug can be compared with the expression intensities generated from the same tissue that has not been treated with the drug. A ratio of these expression intensities indicates the fold-change in gene expression. The passage at [0031] of the '792 publication indicates that the baseline level is the measured gene expression of the untreated diseased cell, and that the genes of interest in the treated diseased cells are either up-regulated or down-regulated relative to the baseline level (emphasis added). Examples 3-6 of the '792 publication indicate how diseased cell lines or cells obtained from patients diagnosed with ***AML*** can be treated with a FTI and how baseline and test gene expression levels can be obtained. Thus, in the '792 publication, the differences in gene expression are all relative to an untreated diseased cell so that it can be determined, for example, if the patient is likely to respond to a FTI. As such, the '792 publication does not anticipate the methods of claim 87-89 as the cited publication does not compare the amount of duplex formed between the recited polynucleotide and nucleic acids of a patient sample to the amount of duplex formed between the recited polynucleotide and nucleic acids of a normal, non-cancerous control. The Office is requested to withdraw the rejection of claims 87-89 under 35 U.S.C. §102(b).

Furthermore, the '792 publication does not direct a person of ordinary skill in the art to use a nucleic acid having the sequence set forth in SEQ ID NO:293 or any of the other nucleic acids set forth in Table 1-3 for diagnosing *lymphoma*, *leukemia*, *carcinoma*, *breast cancer* or *colon cancer*. Again, the '792 publication indicates that the nucleic acids set forth in Tables 1-3 are differentially regulated in cells treated with a FTI. As such, the '792 publication does not render the presently claimed methods obvious. The Office is requested to withdraw the rejection of claims 87-89 under 35 U.S.C. §103.

Double-Patenting

The Office provisionally rejected claims 61, 67, 69-72, 74-81, and 85-90 under the judicially created doctrine of double patenting over claims 42, 43, 44, and 49 of copending

Application No. 10/573,332. Applicants request that the rejection be held in abeyance until there is an indication of otherwise allowable subject matter.

CONCLUSION

It is believed that any pending objections and rejections have been addressed. However, the absence of a reply to a specific rejection, issue, or comment does not signify agreement with or concession of that rejection, issue, or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Applicants submit that claims 61, 69-72, 74-81, and 85-89 are in condition for allowance, which action is requested. Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

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